

REMARKS

I. Status of the Claims

Claims 33-36, 38-46, and 61 are pending in this application. Claims 33, and 61 are independent claims. Claims 1-32 and 47-58 were previously canceled pursuant to a restriction requirement. Rejected claims 59 and 60 have been canceled in favor of new claim 61, which has almost the same scope as claim 22 of U.S. Patent No. 7,114,445 B2, (the “‘445 patent”), which has issued on a related application and over which there was an obviousness-type double patenting rejection set forth in the Office Action.¹ No new matter has been added.

II. Interview Summary

Telephonic interviews were conducted between applicants’ representative and the Examiner on November 1, 2006 and November 2, 2006. It was agreed that the claims of the ‘445 patent are allowable over the art applied against canceled claims 59 and 60 in the Office Action.

The Examiner indicated that a claim, substantially identical to apparatus claim 22 of the ‘445 patent, but reciting a “confectionery” printed substrate instead of a “pharmaceutical” substrate, would be allowable, provided applicants filed a Terminal Disclaimer.

As discussed in the interviews, method claims are co-pending in parent application 09/479,549 (the ‘549 application). The claims in that application are under final rejection. A Notice of Appeal (but not an Appeal Brief) has now been filed. The

¹ The obviousness-type double patenting rejection in the Office Action was over Application No. 10/695,834, which has now issued as the ‘445 patent.

references cited in the Office Action, WO 91/01884 (WO ‘884) and U.S. Patent No. 6,267,997 (Ream), discussed below, have been applied in a rejection of the method claims in the ‘549 application.

The Examiner indicated that method claims, identical in scope to those issued in the ‘445 patent, amended to recite a confectionery substrate, would be considered in a continuation application.

III. Double Patenting

Applicants submit herewith a Terminal Disclaimer to obviate an obviousness type double patenting rejection over the ‘445 patent.

IV. Rejection Under 35 U.S.C. § 103

Claims 59 and 60 were rejected as allegedly being unpatentable over WO 91/01884 (WO ‘884) and U.S. Patent No. 6,267,997 (Ream). This rejection is moot in view of the cancellation of those claims, but in any event, the references do not render the claimed invention obvious.

WO ‘884 does not disclose two printer stations that apply a first and second ink image, but only a first printer station, which applies a background such as a rectangle, followed by an etch station that removes ink from the substrate (See Abstract, and page 10, line 11). The result is a single ink image. Moreover, WO ‘884 teaches away from the presently claimed invention by indicating that highly detailed and defined images could not be formed on shaped edibles by offset printing, at least in part because the pieces float around in the pockets (page 3, lines 20-30). WO ‘884 specifically proposes the laser etch system as a method to overcome the purported drawbacks of offset printing.

The Ream reference, on the other hand, teaches the formation of a registered image on a large flat sheet of chewing gum (col. 5, lines 42-67). This reference is not

relevant to the problem of printing on non-planar surfaces of edibles which "float" around in pockets, as noted in WO '884. It would not have been obvious to use two offset printing stations (which are used in Ream to print registered images on large, flat, self-adhesive sheets of gum) in a system like WO '884, at least because WO '884 expressly indicates that offset printing would not be operable to print detailed images on non-planar edible pieces.

V. Objections to the Claims

The objection to Claim 60 is moot in view of the cancellation of that claim.

CONCLUSION

Favorable reconsideration of the outstanding rejections and objections is respectfully requested on the basis of the foregoing amendment and remarks.

Applicants' attorney of record may be reached in our New York office by telephone at (212) 218-2100. All correspondence should be directed to our below-listed address.

Respectfully submitted,


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